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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/457,207	12/07/1999	JEREMY VANDER WOUDE	MPATENT.160A	7416

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EXAMINER

KUMAR, PANKAJ

ART UNIT	PAPER NUMBER
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2631

DATE MAILED: 04/15/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/457,207

Applicant(s)

WOUDE, JEREMY VANDER *W*

Examiner

Pankaj Kumar

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 27 January 2003.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,3-5,8 and 11 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,3-5,8 and 11 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

## **DETAILED ACTION**

### ***Response to Arguments***

1. Applicant's arguments with respect to non-cancelled claims have been considered but are moot in view of the new ground(s) of rejection.

### ***Response to Amendment***

#### ***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claim 1 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
3. Claim 1 recites the limitation "the signal reporting circuit" in the third line of page 2 of the amendment filed 1/21/2003. There is insufficient antecedent basis for this limitation in the claim.

#### ***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1, 3, 4, 5, 8 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rahamim et al. USPN 5,764,694.

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6. As per claim 1, Rahamim teaches a device for testing the operation of a modem in a computer, the device comprising: a case (inherent to be within a case to reduce the effect of temperature, humidity, liquid spilling and other environmental effects); a first communication port attached to the case and configured to be directly coupled to a modem in a computer thereby forming a primary communication link (Rahamim fig. 1: Rx Sig. between 112 and 140) receive signals from a modem in a computer; a second communication port coupled to the signal reporting circuit (rejected with 112) (Rahamim fig. 1: Rx Sig. between 140 and 118) and configured to be coupled with the computer (Rahamim coupled via other elements) thereby forming a secondary communication link and a signal reporting circuit (Rahamim fig. 1: 118, 120, 132) located within the case and coupled to the first communication port (Rahamim fig. 1: 118 connected via modem to Rx. SIG between 112 and 140) and the second communication port (Rahamim fig. 1: Rx SIG. between 140 and 118), the signal reporting circuit including a microprocessor configured to send a signal to a computer via a secondary communication link (Rahamim fig. 1: send signal to computer from 118 via modem and two RX SIGs.) to initiate the transmission of test data from the modem in the computer (Rahamim does not show that the modem is in the computer; instead, Rahamim shows that the modem is connected to the computer. It would have been obvious to one skilled in the art at the time of the invention to modify Rahamim to teach a modem in the computer since it has been held that rearranging parts of an invention involves only routine skill in the art. In re Japikse, 86 USPQ 70. Also, there is no new and unexpected result between having the modem is inside or outside of the computer. Also, it has been held that forming in one piece an article (i.e. modem inside computer) which has formerly been formed in two pieces (i.e. modem and computer) and put together involves

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only routine skill in the art. Howard v. Detroit Stove Works, 150 U.S. 164 (1893) .) via the primary communication link (Rahamim fig. 1: RX SIG. between 112 and 140) and to evaluate test the transmit capability of the modem in the computer over the primary communication link (Rahamim fig. 1: if the modem is not able to transmit over Rx Sig. between 112 and 140, Rahamim's system will not function and thus this is an evaluation).

7. As per claim 3, Rahamim teaches the device of claim 1 wherein the signal reporting circuit comprises a microprocessor and an analog to digital converter (Rahamim fig. 1: 146) coupled to the microprocessor and the first communication port (Rahamim fig. 1: via other components)

8. As per claim 4, Rahamim teaches the device of claim 1 wherein the signal reporting circuit comprises a microprocessor and a modem coupled to the microprocessor and the first communication port (Rahamim fig. 1: connections of modem 140).

9. As per claim 5, Rahamim teaches a method of testing the operation of a modem in a computer using a portable modem testing device, the method comprising (preamble does not hold patentable weight): coupling the modem in the computer (Rahamim fig. 1: 140) to the portable (Rahamim does not teach it being portable. It would have been obvious to one skilled in the art at the time of the invention to modify Rahamim to teach a portable modem testing device since it has been held that making an old device portable or movable without producing any new and unexpected result involves only routine skill in the art. In re Lindberg, 93 USPQ 23 (CCPA 1952).) modem testing device (Rahamim fig. 1: 118, 120, 132); coupling the computer to the portable modem testing device via an alternate communication link (Rahamim fig. 1: CONT. SIG.); sending a signal from the portable modem testing device to the computer via the alternate

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communication link to initiate testing the operation of the modem in the computer (Rahamim fig. 3); initiating transmission of test data from the modem (Rahamim fig. 3); receiving the transmission from the modem (Rahamim fig. 1: 128) at the portable modem testing device (Rahamim fig. 1: 118, 120, 132); and verifying the transmission (inherent to verify transmission when testing a modem).

10. As per claim 8, Rahamim teaches a method of testing the operation of a modem in a computer using a portable modem testing device, the method comprising: coupling the modem in the computer (Rahamim does not teach the modem being in the computer; instead, Rahamim teaches that the modem is connected to the computer. It would have been obvious to one skilled in the art at the time of the invention to modify Rahamim to teach a modem in the computer since it has been held that rearranging parts of an invention involves only routine skill in the art. In re Japikse, 86 USPQ 70. Also, there is no new and unexpected result between having the modem is inside or outside of the computer. Also, it has been held that forming in one piece an article (i.e. modem inside computer) which has formerly been formed in two pieces (i.e. modem and computer) and put together involves only routine skill in the art. Howard v. Detroit Stove Works, 150 U.S. 164 (1893) .) to the portable modem testing device (Rahamim fig. 1: connecting between 140 and 118); coupling the computer to the modem testing device via an alternate communication link (Rahamim fig. 1: connection between 112, 140 and 118 via CONT SIG and Tx CONT.); sending a signal to a computer via the alternate communication link (Rahamim fig. 1: CONT. SIG.) to initialize the modem in the computer (Rahamim fig. 3); ~~initiating~~ transmission of test data from the portable modem testing device (Rahamim fig. 1: transmission from 118, 120, 132); receiving the transmission from the portable modem testing device at the

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modem in the computer (Rahamim fig. 1 140 receives transmissions from 118); and verifying the transmission (inherent to verify transmission when testing a modem); transmitting test data from the modem to the modem testing device (Rahamim fig. 1: 128 goes from 140 into 118); verifying the test data (inherent to verify test data when testing).

11. As per claim 11, Rahamim teaches a method of testing the operation of a modem in a computer using a ~~portable~~ modem testing device, the method comprising: coupling the modem in the computer (Rahamim does not teach the modem being in the computer; instead, Rahamim teaches that the modem is connected to the computer. It would have been obvious to one skilled in the art at the time of the invention to modify Rahamim to teach a modem in the computer since it has been held that rearranging parts of an invention involves only routine skill in the art. In re Japikse, 86 USPQ 70. Also, there is no new and unexpected result between having the modem is inside or outside of the computer. Also, it has been held that forming in one piece an article (i.e. modem inside computer) which has formerly been formed in two pieces (i.e. modem and computer) and put together involves only routine skill in the art. Howard v. Detroit Stove Works, 150 U.S. 164 (1893) .) to the ~~portable~~ modem testing device (Rahamim fig. 1: 128); coupling the computer to the modem testing device via an alternate communication link (Rahamim fig. 1: 112 coupled to 118 via 140 and two Rx SIGs.); initiating transmission of test data from the modem by sending a signal from the modem testing device (Rahamim fig. 3) over the alternate communication link (Rahamim fig. 1: signal from 118 to 140 via Rx SIG.); receiving the transmission from the modem at the ~~portable~~ modem testing device (Rahamim fig. 1: 128); verifying the transmission (inherent to verify transmission when testing a modem); initiating transmission of test data from the ~~portable~~ modem testing device (Rahamim fig. 3, fig.

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1); receiving the transmission from the portable modem testing device at the modem (Rahamim fig. 3, fig. 1); and verifying the transmission (inherent to verify transmission when testing).


***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Pankaj Kumar whose telephone number is (703) 305-0194. The examiner can normally be reached on Monday through Thursday after 8AM to after 6:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chi H. Pham can be reached on (703) 305-4378. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9314 for regular communications and (703) 872-9314 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3800.

PK  
April 10, 2003

  
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SUPERVISORY PATENT EXAMINER  
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